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EXAMINER

HUTSON, RICHARD G

ART UNIT PAPER NUMBER

1652

DATE MAILED: 09/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,052

Applicant(s)

MOECKEL ET AL.

Examiner

Richard G Hutson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-87 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 18, 19, 24, 25, 30, 31, 36, 37, 38, 39, 40, 41, 83 and 84, drawn to an isolated polynucleotide which encodes a protein (SEQ ID NO: 2), vectors and host cells comprising said polynucleotide, classified in class 435, subclass 252.3.
- II. Claim 11, drawn to an isolated polymerase (SEQ ID NO: 2), classified in class 435, subclass 194.
- III. Claim 12, drawn to an isolated polymerase (SEQ ID NO: 4), classified in class 435, subclass 194.
- IV. Claim 13, drawn to an isolated polymerase (SEQ ID NO: 6), classified in class 435, subclass 194.
- V. Claims 14, 15, 20-21, 26, 27, 32, 33, 40, 42, 85 and 86, drawn to an isolated polynucleotide which encodes a protein (SEQ ID NO: 4), vectors and host cells comprising said polynucleotide, classified in class 435, subclass 252.3.
- VI. Claims 16, 17, 22, 23, 28, 29, 34, 35, 40, 43, 82 and 87, drawn to an isolated polynucleotide which encodes a protein (SEQ ID NO: 6), vectors and host cells comprising said polynucleotide, classified in class 435, subclass 252.3.

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- VII. Claims 44, drawn to *Coryneform glutamicum* DSM 13994, classified in class 435, subclass 252.32.
- VIII. Claims 45, drawn to *Coryneform glutamicum* DSM 13993, classified in class 435, subclass 252.32.
- IX. Claims 46-53, drawn to a process for producing L-amino acids comprising culturing the host cell of claims 24 or 25, and collecting the L-amino acids, classified in class 435, subclass 106.
- X. Claims 54-69, drawn to a process for producing L-amino acids comprising culturing the host cell of claims 26 or 27, and collecting the L-amino acids, classified in class 435, subclass 106.
- XI. Claims 70-73, drawn to a process for producing L-amino acids comprising culturing the host cell of claims 29, and collecting the L-amino acids, classified in class 435, subclass 106.
- XII. Claims 74 and 75, drawn to a process for screening for polynucleotides which encode a protein having RNA polymerase B β -subunit activity, comprising hybridization with the polynucleotide of claims 1 or 3, classified in class 435, subclass 6.
- XIII. Claim 76, drawn to a process for screening for polynucleotides which encode a protein having RNA polymerase B β -subunit activity, comprising hybridization with the polynucleotide of claim 15, classified in class 435, subclass 6.

- XIV. Claim 77, drawn to a process for screening for polynucleotides which encode a protein having RNA polymerase B β -subunit activity, comprising hybridization with the polynucleotide of claim 17, classified in class 435, subclass 6.
- XV. Claims 78 and 80, drawn to method for detecting a nucleic acid with at least 70% homology to the polynucleotide of claims 1 or 3, classified in class 435, subclass 6.
- XVI. Claims 79 and 81, drawn to method for producing a nucleic acid with at least 70% homology to the polynucleotide of claims 1 or 3, classified in class 435, subclass 6.

It is noted that claim 40 has been grouped with Groups I, V and VI and this claim will be examined to the extent that it reads on the elected group.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the polynucleotides of Groups I, V and VI, the proteins of Groups II-IV and the *Coryneform glutamicum* strains of Groups VII and VIII each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The polynucleotides of Groups I, V and VI are comprised of a different nucleic acid sequences and the proteins of Groups II-IV are comprised of different amino acid

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sequences while the *Coryneform glutamicum* strains of Groups VII and VIII are living cells comprising polynucleotides, proteins, carbohydrates and lipids. The polynucleotides have other utility besides encoding proteins such as a hybridization probe, and the proteins can be made synthetically. Additionally, the protein can be used to perform specific biological function(s) which are independent of the function(s) of the DNA molecule. The protein has other utility such as for methods of production of antibodies against the proteins.

Inventions I and IX, XII, XV and XVI are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polynucleotides of Group I can be used in a materially different process such as one in which they are used to synthesize mutant polynucleotides.

The inventions of Groups II-VIII are unrelated to the methods of Groups IX, XII, XV and XVI as they are neither used nor made by the methods of Groups IX, XII, XV and XVI.

Inventions V and X or XIII are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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process of using that product (MPEP § 806.05(h)). In the instant case, the polynucleotides of Group V can be used in a materially different process such as one in which the are used to synthesize mutant polynucleotides.

The inventions of Groups I-IV and VI-VIII are unrelated to the methods of Groups X or XIII as they are neither used nor made by the methods of Groups X or XIII.

Inventions VI and XI, XIV are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polynucleotides of Group VI can be used in a materially different process such as one in which the are used to synthesize mutant polynucleotides.

The inventions of Groups I-V and VII-VIII are unrelated to the methods of Groups XI or XIV as they are neither used nor made by the methods of Groups XI or XIV.

The methods of Groups IX-XVI are independent as they comprise different steps, utilize different products and produce different results.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read "Richard Hutson", with a stylized, flowing script.

Richard Hutson, Ph.D.
Patent Examiner
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September 25, 2002